Docket No.: PMC-003 C230
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
John C. Harvey *et al.*

Patent No.: 7,840,976

Issued: November 23, 2010

For: SIGNAL PROCESSING APPARATUS AND METHODS

Commissioner for Patents
Office of Patent Publication
Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. §1.322

Dear Sir:

Upon reviewing the above-identified patent, Patentee noted a typographical error that should be corrected.

At claim 1, column 287, lines 5-6, insert --at-- so that lines 5-6 read, "1. A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using"

At claim 5, column 287, lines 46-47, insert --at-- so that lines 46-47 read, "5. A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using"

At claim 5, column 287, line 54, insert --to-- after "control a computer" and before "perform a step" so that the phrase reads, "control a computer to perform a step"

At claim 29, column 291, line 34, delete "at its output device"

Applicants did not make these errors. Claims 1, 5, and 29 were originally claims 6, 7, and 125. The claims were last amended via an Examiner's Amendment contained in the Ex Parte Quayle Action mailed October 26, 2009. A copy of this mailing is attached as Exhibit A. The Examiner's Amendment was authorized by Applicants on October 7, 2009. No later amendments were submitted by Patentee or issued by the Examiner.

Patent 7,840,976 issued November 23, 2010, failed to reflect the claims as amended by the October 26, 2009 Examiner's Amendment.

In the issued claims 1 and 5, the Office deleted the second "at" from the phrase "at at least one" such that the claims read "…delivering a receiver specific program at least one of a plurality of receiver stations…" However, claims 1 and 5, originally claims 6 and 7, should contain the second "at", such that the claims read "…delivering a receiver specific program at least one of a plurality of receiver stations…" This is evident by the October 26, 2009 Examiner's Amendment. The word "at" was not deleted from the claims in the October 26, 2009 Examiner's Amendment and should not have been deleted in the issued claims.

The October 26, 2009 Examiner's Amendment amended claim 7 to delete "compute" after 'to control a computer" and insert "perform a step for computing" such that within the transmitting step should read "…to control a computer **to** perform a step for computing a receiver specific value…" In the October 26, 2009 Examiner's Amendment, the Office mistakenly deleted the word "to" from claim 7 of the Examiner's Amendment. The word "to" was never deleted in any prior amendments and should have been part of the claim 7 in the October 26, 2009 Examiner's Amendment. This is evident by the previous version of the claim, as presented in Applicant's March 5, 2003 Request for Reconsideration (Exhibit B). The word "to" should not have been deleted from the claim.

Finally, the October 26, 2009 Examiner's Amendment deleted the phrase "at its output device." This deletion was not reflected in the issued claim.

Accordingly, Patentee believes that the aforementioned errors were caused by the Office, and that no fee is due for the Certificate of Correction. However, if any fees are required, the Director is hereby authorized to charge any fees to our Deposit Account No. 50-4494.

Transmitted herewith is a proposed Certificate of Correction effecting such amendment.

Patentee respectfully solicits the granting of the requested Certificate of Correction.

Dated: December 9, 2010

Respectfully submitted,

By /Thomas J. Scott, Jr./
Thomas J. Scott, Jr.
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Attorney for Patentee

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/447,712	05/23/1995	JOHN C. HARVEY	5634.127	8860

70813 7590 10/26/2009

GOODWIN PROCTER LLP
901 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20001

EXAMINER	
LE, BRIAN Q	

ART UNIT	PAPER NUMBER
2624	

NOTIFICATION DATE	DELIVERY MODE
10/26/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AAlpha-Kpetewama@goodwinprocter.com
patentdc@goodwinprocter.com

Office Action Summary	Application No.	Applicant(s)	
	08/447,712	HARVEY ET AL.	
	Examiner	Art Unit	
	BRIAN Q. LE	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2009*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *See Continuation Sheet* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *6,7,21,22,25-29,33,34,36-38,55,56,60,78,79,89,103-106,108-111,125,127 and 128* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/5/03; 3/14/03*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *10/07/2009* .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 6,7,21,22,25-29,33,34,36-38,55,56,60,78,79,89,103-106,108-111,125,127 and 128.

DETAILED ACTION

1. This application is in condition for allowance except for the following formal matters: Administrative Requirement as set forth below.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

2. As the application has closed on the merits, applicant is now required to make the submission to comply with the Administrative Requirement as followed: Applicants' compliance will take the form of one of the following actions:

(1) filing terminal disclaimers in each of the related co-pending applications terminally disclaiming each of the other co-pending applications;

(2) providing an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by applicant and that no conflicting claims exists between the applications; or

(3) resolving all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications.

3. The Examiner's Amendment to the record appears below. Authorization for this Examiner's Amendment was granted by both attorneys, Thomas J. Scott Jr. (Reg. No. 27,836) and Carl Benson (Reg. No. 38,378) on 10/07/2009.

The Claims have been amended as follows:

1-5. (Cancelled)

6. (Currently amended) A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using a computer to perform the following steps of:

generating a first control signal at a transmitter station;

receiving a second control signal at said transmitter station, said second control signal operative to communicate said first control signal; and

transmitting said first control signal to said at least one of said plurality of receiver stations in response to said second control signal, said first control signal effective at said at least one of said plurality of receiver stations to control a computer to ~~compute~~ perform a step for computing a receiver specific value by processing information stored in said computer, ~~generate~~ a step for generating a receiver specific signal based on said receiver specific value, ~~and output programming based on~~ a step for placing said receiver specific signal at a specific memory location, a step for outputting said receiver specific signal, a step for clearing said receiver specific signal from said specific memory location, and a step for delivering programming including said receiver specific signal in a period of time between said step for placing said receiver specific signal at said specific memory location and said step for clearing said receiver specific signal from said specific memory location.

7. (Currently amended) A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using a computer to perform the following steps of:

storing a control signal and selected data at a transmitter station; and

transmitting a transmission including said stored control signal and said stored selected data, said control signal effective at said at least one of a plurality of receiver stations to control a computer ~~compute~~ perform a step for computing a receiver specific value by processing information stored in said computer, ~~generate~~ a step for generating a receiver specific signal based on said receiver specific value, ~~and output programming based on~~ a step for placing said receiver specific signal at a specific memory location, a step for outputting said receiver specific signal, a step for clearing said receiver specific signal from said specific memory location, and a step for delivering programming including said receiver specific signal in a period of time between said step for placing said receiver specific signal at said specific memory location and said step for clearing said receiver specific signal from said specific memory location

8-20. (Cancelled)

21. (Previously presented) The method of claim 6, said method further comprising the steps of: originating an instruct signal at said transmitter station; and generating some portion of at least one of a computer program and a data module in response to said instruct signal.

22. (Previously presented) The method of claim 6, wherein said receiver specific program includes a presentation of at least two instances of combined medium programming, said method further comprising the steps of:

transmitting a portion of each of said two instances of combined medium programming.-

23-24. (Cancelled)

25. (Currently amended) A method for controlling the transmission of a control signal from an intermediate transmitter station to a receiver station, comprising using a computer to perform the following steps of:

receiving, at said intermediate transmitter station, information regarding a first control signal; receiving a second control signal operative to cause a first computer at said intermediate transmitter station to select data and to communicate said first control signal to a memory of said computer based on said data; and

transmitting, to said receiver station, said selected first control signal, said selected first control signal operative at said receiver station to control a second computer to ~~generate~~ perform a step for generating a receiver specific value by processing information stored in said second computer, ~~generate~~ a step for generating a receiver specific signal based on said receiver specific value, ~~and communicate programming~~ a step for placing said receiver specific signal at a specific memory location, a step for communicating said receiver specific signal to an output device ~~based on~~, a step for clearing said receiver specific signal from said specific memory location, and a step for delivering programming including said receiver specific signal in a period time

between said step for placing said receiver specific signal at a specific memory location and said step for clearing said receiver specific signal from said specific memory location.

26. (Previously presented) The method of claim 25, wherein said first control is generated at said intermediate transmitter station before said second control signal is received.

27. (Previously presented) The method of claim 25, wherein said step of transmitting said first selected control signal is based on a third control signal.

28. (Previously presented) The method of claim 25, further comprising the step of storing said selected first control signal at a storage device included within said intermediate transmitter station.

29. (Previously presented) The method of claim 28, wherein said transmitting step is performed at a specific time according to a third control signal.

30-32. (Cancelled)

33. (Previously presented) The method of claim 6, further comprising the step of receiving operating instructions at said transmitter station, said operating instructions effective to control a processor at said transmitter station, wherein said first control signal and said second control signal are processed by said processor under control of said operating instructions.

34. (Previously presented) The method of claim 7, further comprising the step of transmitting operating instructions to said computer, said operating instructions effective to control said computer, wherein said control signal is processed by said computer under control of said operating instructions.

35. (Cancelled) ~~A method of delivering a receiver specific program at a receiver station having a computer and an output device, said method comprising the steps of:~~

~~(a) receiving a broadcast or cablecast information transmission comprising a plurality of units~~

~~of programming and a control signal;~~

~~(b) communicating each of said plurality of units of programming to at least one of:~~

~~(1) said computer for processing; and~~

~~(2) said output device for delivery to a user;~~

~~(c) detecting said control signal in said broadcast or cablecast information transmission and passing said detected control signal to said computer;~~

~~(d) controlling said computer based on said detected and passed control signal, said step of controlling comprising:~~

~~(1) generating a receiver specific value by processing information that is stored in said computer;~~

~~(2) selecting at least one of said plurality of units of programming based on said receiver specific computer generated value; and~~

~~(3) outputting said selected at least one of said plurality of units of programming; and~~

~~(c) delivering a presentation of two or more units of programming, said two or more units of programming including said selected at least one of said plurality of units of programming~~.

36. (Currently amended) The method of claim ~~35~~ 55 wherein ~~said selected~~ at least ~~one~~ a portion of said ~~plurality of units of~~ combined medium programming is delivered as printed text.

37. (Currently amended) The method of claim ~~35~~ 55 wherein ~~said selected~~ at least ~~one~~ a portion of said ~~plurality of units of~~ combined medium programming includes audio, and said step ~~of outputting~~ for delivering comprises placing said audio into ~~said~~ audio RAM.

38. (Currently amended) The method of claim ~~35~~ 55, ~~wherein said selected at least one of said plurality of units of programming includes information to be displayed in video, and~~ said step ~~of outputting~~ step for placing said receiver specific datum at a specific memory location comprises placing said ~~information to be displayed in video~~ receiver specific datum into a video RAM.

39-54. (Cancelled)

55. (Currently amended) A method of signal processing at a receiver station having a computer and an output device to deliver at the output device an output of combined medium

programming including a receiver specific datum within a broadcast or cablecast program, said method comprising using said computer to perform the following steps of:

(a) receiving an information transmission comprising a broadcast or cablecast program and a control signal;

(b) selecting said received broadcast or cablecast program from the information transmission and transferring it to the output device for delivery to the user;

(c) detecting said control signal in the information transmission and passing said detected control signal to said computer; and

(d) controlling said computer based on said control signal, said step of controlling comprising:

(1) a step for generating a receiver specific datum by processing first information that is stored in said computer;

(2) a step for placing said receiver specific datum at a specific memory location of the computer;

(3) a step for communicating said receiver specific datum from said specific memory location to said output device; and subsequently

(4) a step for clearing said receiver specific datum from said specific memory location; and

~~whereby~~ (5) a step for delivering combined medium programming of said received broadcast or cablecast program including said receiver specific datum ~~is delivered~~ in a period of time between said step ~~of~~ for placing said receiver specific datum at said specific memory

location and said step ~~of~~ for clearing said receiver specific datum from said specific memory location.

56. (Currently amended) The method of claim 55, wherein the step ~~of~~ for generating a receiver specific datum by processing information that is stored in the computer is achieved by executing a computer program which is loaded at said computer in response to said control signal.

57-59. (Cancelled)

60. (Previously presented) The method of claim 55, wherein processor instructions executed by said computer to perform said step of controlling are detected in the broadcast or cablecast information transmission.

61-77. (Cancelled)

78. (Currently Amended) A receiver station apparatus for signal processing to deliver combined medium programming including a receiver specific datum within a broadcast or cablecast program, comprising:

an output device, said output device for delivering said program;

a decoder for detecting control signals in an information transmission;

a computer operatively connected to said output device and said decoder, said computer having a specific memory location, and for performing the following steps based upon said control signals:

(1) a step for generating a receiver specific datum by processing information that is stored in said computer;

(2) a step for placing said receiver specific datum in said specific memory location;

(3) a step for communicating said receiver specific datum from said specific memory location to said output device; ~~and subsequently~~

(4) a step for clearing said receiver specific datum from said specific memory location, and

~~thereby~~ (5) a step for delivering combined medium programming including said receiver specific datum during said broadcast or cablecast program in the period of time between said step for placing said datum at said memory location and said step for clearing said datum from said memory location.

79. (Currently amended) A method of communicating mass medium program material from a transmitter station to a plurality of receiver stations each of which includes a broadcast or cablecast program receiver, an output device, a control signal detector, a computer, ~~and with each said receiver station adapted to detect the presence of at least one control signal, to generate a receiver specific datum in response to a detected specific control signal, and to deliver at said output device combined medium programming including said receiver specific datum within a~~

~~broadcast or cablecast program~~, said method comprising using a processor to perform the following steps of:

receiving at a transmitter station a program to be transmitted;

storing at said transmitter station a control signal which at said plurality of receiver stations operates to ~~generate~~ control each said computer to perform a step for generating a receiver specific value ~~and to select~~, a step for selecting audio for output based on said receiver specific value, a step for placing said audio in a specific memory location, a step for communicating said audio to said output device, a step for clearing said audio from said specific memory location, a step for delivering at said output device said combined medium programming including said audio in a time period between said step for placing said audio in a specific memory location and said step for clearing said audio from said specific memory location; and

transmitting at a specific time an information transmission comprising said program and said control signal.

80-88. (Cancelled)

89. (Previously presented) The method of claim 79, wherein a controller at said transmitter station controls the passing of a specific received signal, said method further comprising the steps of detecting embedded information in said specific received signal and controlling the passing of said specific received signal on the basis of said detected embedded information.

90-102. (Cancelled)

103. (Previously presented) The method of claim 79, wherein a plurality of signals is received from one or more remote stations at said transmitter station and at least one is stored at said transmitter station which is operative to schedule transmission, said method further comprising the steps of adapting said transmitter station to store a schedule and causing said transmitter to transmit in accordance with said schedule.

104. (Previously presented) The method of claim 103, further comprising the step of causing said transmitter station to generate, in accordance with said schedule, at least portions of signals to be transmitted.

105. (Previously presented) The method of claim 79, further comprising the steps of:

receiving at said transmitter station an information transmission from a remote station;

detecting in the information transmission from said remote station an instruct signal;

executing said instruction set at a transmitter station computer in response to said instruct signal; and

selecting, based on said instruction set, information to be processed at a receiver station or communicating information to be associated with said program.

106. (Previously presented) The method of claim 79, wherein a controller at said transmitter station controls a memory location to communicate to said transmitter a selected control signal, said method further comprising the steps of detecting a first instruct signal which is effective at the transmitter station to instruct transmission, and inputting said first instruct signal to said controller thereby to cause said memory location to communicate a selected control signal.

107. (Cancelled)

108. (Previously presented) The method of claim 106, further comprising the steps of storing said first instruct signal at said transmitter station, and controlling said memory location to communicate a selected control signal at a scheduled time according to said first instruct signal.

109.(Previously presented) The method of claim 106, further comprising the step of controlling said memory location to communicate said program to said transmitter based on a second instruct signal.

l10.(Previously presented) The method of claim 109, further comprising the steps of detecting a selected control signal communicated from said memory location and programming a controller to respond to a control signal communicated from said memory location.

111. (Previously presented) The method of claim 106, further comprising the step of embedding first instruct signal in said program thereby to enable said controller to respond to said embedded said first instruct signal at a time when said program is being communicated.

112-124. (Cancelled)

125. (Currently amended) A transmitter station apparatus for processing a signal and communicating mass medium program materials to present at each of a plurality of receiver stations a combined output of a broadcast or cablecast program and a receiver specific computer generated datum, with each of said receiver stations having an output device for receiving and delivering the broadcast or cablecast program and other information, each said station also having a microcomputer with a specific memory location operatively connected to said output device for storing and outputting information to said output device, said transmitter station apparatus comprising:

a broadcast or cablecast transmitter for communicating to a plurality of receiver stations an information transmission;

a program input receiver operatively connected to said transmitter for communicating the program to said transmitter;

a memory or recorder operatively connected to said transmitter for storing and communicating a first control signal which at the receiver station operates to generate the receiver specific datum; and

an input device operatively connected to said memory or recorder for causing said memory or recorder to communicate said first control signal at a specific time to said transmitter, thereby to communicate said program and said first control signal to said receiver stations and cause each of said plurality of receiver stations to deliver said program at its output device ~~generate~~ by controlling said microcomputer to perform the step for generating a receiver station specific datum, ~~place~~ a step for placing its receiver station specific datum at its memory location, a step for communicating said receiver station specific datum from its memory location to said output device, a step for clearing said receiver specific datum from its memory location ~~for a period of time~~, and ~~deliver~~ a step for delivering a combined output of said broadcast or cablecast program and its receiver station specific datum ~~at its output device~~ in a period of time between said step for placing its receiver station specific datum at its memory location and said step for clearing said receiver specific datum from its memory location.

126. (Cancelled)

127. (Currently amended) A method of communicating mass medium program material to ~~a plurality of~~ at least one receiver ~~stations each of~~ station which includes a broadcast or cablecast program receiver, an output device, a control signal-detector, a computer with a specific memory location capable of communicating to said output device~~, and with each said receiver station adapted to detect the presence of at least one control signal, to generate a receiver specific datum in response to a detected specific control signal and to deliver at said output device combined medium programming including said receiver specific datum within a~~

~~broadcast or cablecast program~~, said method comprising using a processor to perform the following steps of:

receiving at a transmitter station a program to be transmitted;

generating data related to said program;

generating at said transmitter station a first control signal using said generated data which at ~~the~~ said at least one receiver station operates to ~~generate the~~ control said computer to perform a step for generating a receiver specific datum, a step for placing said receiver specific datum in a specific memory location, a step for communicating said receiver specific datum to said output device, a step for clearing said receiver specific datum from said specific memory location, and a step for delivering at said output device combined medium programming including said receiver specific datum in a period of time between said step for placing said receiver specific datum in a specific memory location and said step for clearing said receiver specific datum from said specific memory location;

receiving a second control signal; and

transmitting at least one of said program and said first control signal in response to said second control signal.

128. (Previously presented) The method of claim 127, said method further comprising the step of transmitting said second control signal to said transmitter station.

REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance:

Regarding independent claims 6, 7, 25, 55, 78, 79, 125 and 127, the Applicants have agreed to invoke 112, sixth paragraph by added the language "step for" to the significant limitations of the claims. Therefore, the prior art of records do not show the limitations "a step for placing said receiver specific signal at a specific memory location, a step for outputting said receiver specific signal, a step for clearing said receiver specific signal from said specific memory location, and a step for delivering programming including said receiver specific signal in a period of time between said step for placing said receiver specific signal at said specific memory location and said step for clearing said receiver specific signal from said specific memory location." (or similar in scope) in combination with other limitations of the claims.

Other claims are allowed because of their dependency on the independent claims.

2. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

CONTACT INFORMATION

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN Q. LE whose telephone number is (571)272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589 or Daniel Swerdlow 571-272-7531. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian Q Le/
Primary Examiner, Art Unit 2624

October 22, 2009

EXHIBIT B

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	John C. Harvey and James W. Cuddihy
Serial No.	:	08/447,712
Docket No.	:	5634.127
Filed	:	May 23, 1995
For	:	SIGNAL PROCESSING APPARATUS AND METHODS
Group Art Unit	:	2611
Examiner	:	Bhavesh M. MEHTA

Commissioner for Patents
Washington, D.C. 20231

AMENDMENT AND REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

I. AMENDMENT

This Amendment and Request for Reconsideration replies to the Office action mailed September 5, 2002 (Office action). Applicants respectfully request that the following amendments be entered into the above-captioned application:

Applicants request entry of the following amendments to the claims.

Please amend claims 6, 7, 21, 22, 26-29, 33-38, 55, 56, 60, 78, 79, 103-105, 109, 111, 125, 127, and 128 as follows.

Please cancel claims 129-139 without prejudice.

Claim 89, 106, 108, and 110 remain unchanged.

Claims 6, 7, 21, 22, 26-29, 33-38, 55, 56, 60, 78, 79, 89, 103-106, 108-111, 125, 127, and 128

2611 #7

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	John C. Harvey and James W. Cuddihy
Serial No.	:	08/447,712
Docket No.	:	5634.127
Filed	:	May 23, 1995
For	:	SIGNAL PROCESSING APPARATUS AND METHODS
Group Art Unit	:	2611
Examiner	:	Bhavesh M. Mehta
Confirmation No.	:	8860

Commissioner for Patents
Washington, DC 20231

Transmitted herewith is a Petition for Three Month Extension of Time Under 37 C.F.R. § 1.136, and an Amendment and Request for Reconsideration Under 37 C.F.R. § 1.111.

CLAIMS AS AMENDED						
	Claims Remaining After Amendment	Highest Number Previously Paid For	Extra	Rate		Amount
				Large Entity	Small Entity	
Number of Claims in Excess of 20	32	126	0	$ 18.00	$ 9.00	$ 0.00
Independent Claims in Excess of 3	9	17	0	$ 84.00	$ 42.00	$ 0.00
First Presentation of Multiple Dependent Claims				$ 280.00	$ 140.00	$ 0.00
Extension Fee: a) One Month				$ 110.00	$ 55.00	$ 0.00
b) Two Months				$ 410.00	$ 205.00	$ 0.00
c) Three Months				$ 930.00	$ 465.00	$ 930.00
d) Four Months				$1450.00	$ 725.00	$ 0.00
e) Five Months				$1970.00	$ 985.00	$ 0.00
Other:						$ 0.00
TOTAL FEE DUE						$ 930.00

☐ No additional fee is required.
☒ A check in the amount of $ **930.00** is attached.
☐ Charge $ _____ to Deposit Account No. 50-0206.
☒ Charge any additional fees or credit any overpayment to Deposit Account No. 50-0206.

Small Entity Status Claim:
☐ is hereby requested.
☐ is of record in this application.

Date: March 5, 2003

Respectfully submitted,

Carl L. Benson
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HUNTON & WILLIAMS
1900 K St., N.W./Suite 1200
Washington, DC 20006

are pending.

6. (Three Times Amended) A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising the steps of:

generating a first control signal at a transmitter station;

receiving a second control signal at said transmitter station, said second control signal operative to communicate said first control signal; and

transmitting said first control signal to said at least one of said plurality of receiver stations in response to said second control signal, said first control signal effective at said at least one of said plurality of receiver stations to control a computer to compute a receiver specific value by processing information stored in said computer, generate a receiver specific signal based on said receiver specific value, and output programming based on said receiver specific signal.

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7. (Three Times Amended) A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising the steps of:

storing a control signal and selected data at a transmitter station; and

transmitting a transmission including said stored control signal and said stored selected data, said control signal effective at said at least one of a plurality of receiver stations to control a computer to compute a receiver specific value by processing information stored in said computer including said selected data, generate a receiver specific signal based on said receiver specific value, and output programming based on said receiver specific signal.

52

21. (Three Times Amended) The method of claim 6, said method further comprising the steps

of:

originating an instruct signal at said transmitter station; and

J2

generating some portion of at least one of a computer program and a data module in response to said instruct signal.

22. (Twice Amended) The method of claim 6, wherein said receiver specific program includes a presentation of at least two instances of combined medium programming, said method further comprising the steps of:

J3

transmitting a portion of each of said two instances of combined medium programming.

25. (Three Times Amended) A method for controlling the transmission of a control signal from an intermediate transmitter station to a receiver station, comprising the steps of:

receiving, at said intermediate transmitter station, information regarding a first control signal;

receiving a second control signal operative to cause a first computer at said intermediate

J4

transmitter station to select data and to communicate said first control signal to a memory of said computer based on said data; and

transmitting, to said receiver station, said selected first control signal, said selected first control signal operative at said receiver station to control a second computer to generate a receiver specific value by processing information stored in said second computer, generate a receiver specific signal based on said receiver specific value, and communicate programming to an output device based on said receiver specific signal.

J5

26. (Amended) The method of claim 25, wherein said first control is generated at said

intermediate transmitter station before said second control signal is received.

J8

27. (Amended) The method of claim 25, wherein said step of transmitting said first selected control signal is based on a third control signal.

28. (Twice Amended) The method of claim 25, further comprising the step of storing said selected first control signal at a storage device included within said intermediate transmitter station.

J10

29. (Twice Amended) The method of claim 28, wherein said transmitting step is performed at a specific time according to a third control signal.

33. (Twice Amended) The method of claim 6, further comprising the step of receiving

J11

operating instructions at said transmitter station, said operating instructions effective to control a processor at said transmitter station, wherein said first control signal and said second control signal are processed by said processor under control of said operating instructions.

34. (Amended) The method of claim 7, further comprising the step of transmitting operating

J8

instructions to said computer, said operating instructions effective to control said computer, wherein said control signal is processed by said computer under control of said operating instructions.

J9

35. (Twice Amended) A method of delivering a receiver specific program at a receiver station having a computer and an output device, said method comprising the steps of:

(a) receiving a broadcast or cablecast information transmission comprising a plurality of units

of programming and a control signal;

(b) communicating each of said plurality of units of programming to at least one of:

(1) said computer for processing; and

(2) said output device for delivery to a user;

(c) detecting said control signal in said broadcast or cablecast information transmission and passing said detected control signal to said computer;

(d) controlling said computer based on said detected and passed control signal, said step of controlling comprising:

(1) generating a receiver specific value by processing information that is stored in said computer;

(2) selecting at least one of said plurality of units of programming based on said receiver specific computer generated value; and

(3) outputting said selected at least one of said plurality of units of programming; and

(e) delivering a presentation of two or more units of programming, said two or more units of programming including said selected at least one of said plurality of units of programming.

36. (Amended) The method of claim 35 wherein said selected at least one of said plurality of units of programming is delivered as printed text.

37. (Amended) The method of claim 35 wherein said selected at least one of said plurality of units of programming includes audio, and said step of outputting comprises placing said audio into said audio RAM.

38. (Amended) The method of claim 35, wherein said selected at least one of said plurality of units of programming includes information to be displayed in video, and said step of outputting comprises placing said information to be displayed in video into a video RAM.

55. (Amended) A method of signal processing at a receiver station having a computer and an output device to deliver at the output device an output of combined medium programming including a receiver specific datum within a broadcast or cablecast program, said method comprising the steps of:

(a) receiving an information transmission comprising a broadcast or cablecast program and a control signal;

(b) selecting said received broadcast or cablecast program from the information transmission and transferring it to the output device for delivery to the user;

(c) detecting said control signal in the information transmission and passing said detected control signal to said computer; and

(d) controlling said computer based on said control signal, said step of controlling comprising:

(1) generating a receiver specific datum by processing first information that is stored in said computer;

(2) placing said receiver specific datum at a specific memory location of the computer;

(3) communicating said receiver specific datum from said specific memory location to said output device; and subsequently

(4) clearing said receiver specific datum from said specific memory location;

whereby combined medium programming of said received broadcast or cablecast program including said receiver specific datum is delivered in a period of time between said step of placing

said receiver specific datum at said specific memory location and said step of clearing said receiver specific datum from said specific memory location.

J11

56. (Amended) The method of claim 55, wherein the step of generating a receiver specific datum by processing information that is stored in the computer is achieved by executing a computer program which is loaded at said computer in response to said control signal.

60. (Amended) The method of claim 55, wherein processor instructions executed by said computer to perform said step of controlling are detected in the broadcast or cablecast information transmission.

J12

78. (Amended) A receiver station apparatus for signal processing to deliver combined medium programming including a receiver specific datum within a broadcast or cablecast program, comprising:

an output device, said output device for delivering said program;

J13

a decoder for detecting control signals in an information transmission;

a computer operatively connected to said output device and said decoder, said computer having a specific memory location, and for performing the following steps based upon said control signals:

(1) generating a receiver specific datum by processing information that is stored in said computer;

(2) placing said receiver specific datum in said specific memory location;

(3) communicating said receiver specific datum from said specific memory location to said output device; and subsequently

(4) clearing said receiver specific datum from said specific memory location,

thereby delivering combined medium programming including said receiver specific datum during said broadcast or cablecast program in the period of time between placing said datum at said memory location and clearing said datum from said memory location.

79. (Amended) A method of communicating mass medium program material from a transmitter station to a plurality of receiver stations each of which includes a broadcast or cablecast program receiver, an output device, a control signal detector, a computer, and with each said receiver station adapted to detect the presence of at least one control signal, to generate a receiver specific datum in response to a detected specific control signal, and to deliver at said output device combined medium programming including said receiver specific datum within a broadcast or cablecast program, said method comprising the steps of:

receiving at a transmitter station a program to be transmitted;

storing at said transmitter station a control signal which at said plurality of receiver stations operates to generate a receiver specific value and to select audio for output based on said receiver specific value; and

transmitting at a specific time an information transmission comprising said program and said control signal.

89. (Unchanged) The method of claim 79, wherein a controller at said transmitter station controls the passing of a specific received signal, said method further comprising the steps of detecting embedded information in said specific received signal and controlling the passing of said specific received signal on the basis of said detected embedded information.

103.(Amended) The method of claim 79, wherein a plurality of signals is received from one or more remote stations at said transmitter station and at least one is stored at said transmitter station which is operative to schedule transmission, said method further comprising the steps of adapting said transmitter station to store a schedule and causing said transmitter to transmit in accordance with said schedule.

104.(Amended) The method of claim 103, further comprising the step of causing said transmitter station to generate, in accordance with said schedule, at least portions of signals to be transmitted.

105.(Amended) The method of claim 79, further comprising the steps of:

receiving at said transmitter station an information transmission from a remote station;

detecting in the information transmission from said remote station an instruct signal;

executing said instruction set at a transmitter station computer in response to said instruct signal; and

selecting, based on said instruction set, information to be processed at a receiver station or communicating information to be associated with said program.

106.(Unchanged) The method of claim 79, wherein a controller at said transmitter station controls a memory location to communicate to said transmitter a selected control signal, said method further comprising the steps of detecting a first instruct signal which is effective at the transmitter station to instruct transmission, and inputting said first instruct signal to said controller thereby to

cause said memory location to communicate a selected control signal.

108.(Unchanged) The method of claim 106, further comprising the steps of storing said first instruct signal at said transmitter station, and controlling said memory location to communicate a selected control signal at a scheduled time according to said first instruct signal.

109.(Amended) The method of claim 106, further comprising the step of controlling said memory location to communicate said program to said transmitter based on a second instruct signal.

110.(Amended) The method of claim 109, further comprising the steps of detecting a selected control signal communicated from said memory location and programming a controller to respond to a control signal communicated from said memory location.

111.(Unchanged) The method of claim 106, further comprising the step of embedding first instruct signal in said program thereby to enable said controller to respond to said embedded said first instruct signal at a time when said program is being communicated.

125.(Amended) A transmitter station apparatus for processing a signal and communicating mass medium program materials to present at each of a plurality of receiver stations a combined output of a broadcast or cablecast program and a receiver specific computer generated datum, with each of said receiver stations having an output device for receiving and delivering the broadcast or cablecast program and other information, each said station also having a microcomputer with a specific memory location operatively connected to said output device for storing and outputting

information to said output device, said transmitter station apparatus comprising:

a broadcast or cablecast transmitter for communicating to a plurality of receiver stations an information transmission;

a program input receiver operatively connected to said transmitter for communicating the program to said transmitter;

a memory or recorder operatively connected to said transmitter for storing and communicating a first control signal which at the receiver station operates to generate the receiver specific datum; and

an input device operatively connected to said memory or recorder for causing said memory or recorder to communicate said first control signal at a specific time to said transmitter, thereby to communicate said program and said first control signal to said receiver stations and cause each of said plurality of receiver stations to deliver said program at its output device, generate a receiver station specific datum, place its receiver station specific datum at its memory location for a period of time, and deliver a combined output of said broadcast or cablecast program and its receiver station specific datum at its output device.

127.(Twice Amended) A method of communicating mass medium program material to a plurality of receiver stations each of which includes a broadcast or cablecast program receiver, an output device, a control signal detector, a computer with a specific memory location capable of communicating to said output device, and with each said receiver station adapted to detect the presence of at least one control signal, to generate a receiver specific datum in response to a detected specific control signal, and to deliver at said output device combined medium programming including said receiver specific datum within a broadcast or cablecast program, said method comprising the steps of:

receiving at a transmitter station a program to be transmitted;

generating data related to said program;

generating at said transmitter station a first control signal using said generated data which at the receiver station operates to generate the receiver specific datum;

receiving a second control signal; and

transmitting at least one of said program and said first control signal in response to said second control signal.

128.(Amended) The method of claim 127, said method further comprising the step of transmitting said second control signal to said transmitter station.

II. REMARKS

Applicants have reviewed the Office action mailed September 5, 2002 and fully address in this response the objections and rejections contained therein.

The Office action begins with Section I that recites a number of issues that are neither rejections of nor objections to the claims of the instant application. Applicants address Section I of the Office action below, but note that the issues raised are not relevant to the patentablity of the claims in this application. For this reason, Section I of the Office action is improper and should therefore be withdrawn in its entirety.

Section I of the Office action is followed by Sections II-IV that assert the following rejections of the pending claims.

Section II rejects claims 6, 7, 25, 79, 125, 129, and 139 under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter of the invention.

Section III rejects claims 6, 7, 21, 22, 25-29, 33-38, 55, 56, 60, 78, 79, 89, 103-106, 108-111, 125, 127-131, and 133-139 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Section IV rejects claims 6, 7, 25, 35, 55, 78, 79, 125, 127, 129, and 139 under 35 U.S.C. § 103(a) as allegedly being unpatentable over "remote switching control system" as evidenced by British Patent Publication No. 959,274 to Germany and U.S. Patent No. 4,847,698 to Freeman.

Applicants reply herein to each ground of rejection presented Office action. Applicants hereby request reconsideration of the instant application.

A. Response To Section I Of The Office Action.

The Office action begins by identifying a list of 30 "Examples" of issues that have been raised in some of applicants' copending applications. The Examiner alleges that in some cases applicants have "handled and addressed" these issues inconsistently in different applications. The Examiner states that the list of "Examples" will be maintained by the Patent Office "in an attempt to ensure consistency in the way that these issues are handled between applications in the future." Office action, p. 2.

Applicants respectfully submit that the "Examples" are simply irrelevant to the prosecution of the instant application for a number of reasons. The Patent Office itself has acknowledged that the list of 30 Examples is not relevant to certain applications because applicants have not asserted priority in those applications to the filing date of applicants' 1981 application:

> It is examiners position that after a series of interview, it has been mutually agreed upon that the instant application is entitled the earlier priority date of 9/11/87 based on the 07/096,096 application and not the 11/3/81 date based on the 06/317,510 application. Therefore, the written description and the enablement under 112 1st paragraph should be limited to the 1987 specification only. Additionally, the remarks set forth in Paragraph III, items 1-30 [the "Examples"] of the instant office action are carried over from other office actions in similar cases and are presented herein because in the past there have been disagreements between the priority date that the applicants are entitled to. The examiner will withdraw paragraph III from subsequent actions in the instant case application if applicants confirm on record in the next communication that the instant application is entitled to only the 1987

priority date and the citations for claim support will be only provided for the 1987 specification.[1]

The Examiner's position that he will withdraw the irrelevant 30 Examples only if "applicants confirm on record in the next communication that the instant application is entitled to only the 1987 priority date" is improper. Whether or not *a particular claim* is afforded the benefit of an earlier filing date under § 120 simply depends on whether the requirements of § 120 are met *for that claim*. A claim either is or is not entitled to an earlier filing date, and such a determination cannot be made without conducting the appropriate claim-by-claim analysis required by the controlling authorities. Of course, it is applicants' decision whether or not to invoke § 120 in order to overcome an intervening reference. In the instant application, applicants have distinguished the teachings of the intervening reference applied by the Examiner on the merits and have *not* invoked § 120 to avoid the intervening reference. Moreover, applicants have demonstrated specification support below only with respect to the 1987 specification. Accordingly, the 30 Examples should be withdrawn.

Applicants question the relevance of the 30 Examples, as well as applicants' need to respond to these Examples, because none of the examples forms the basis for any objection to or rejection of a pending claim. *See* 37 C.F.R. § 1.111 ("In order to be entitled to reconsideration or further examination, the applicant . . . must reply to every ground of objection and rejection in the prior Office action."). Further, none of the Examples even refers to any claims that are presently pending in the instant application. Accordingly, the 30 Examples simply have no bearing on the prosecution of the claims pending in the instant application, and are therefore improper.

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[1] This paragraph was included in Office actions in the following applications: 08/487,397 mailed 9/06/02; 08/438,011 mailed 9/06/02; 08/447,496 mailed 9/06/02; and 08/479,215 mailed 9/05/02.

Applicants further question the basis for including the 30 Examples in the instant application and applicants' need to respond to the Examples, because the vast majority of the Examples have appeared at least once before in other applications and because applicants have already responded to the vast majority of the Examples on the record in their copending applications. For example, all 30 Examples appear in identical form in the 07/17/02 Office action received in application Ser. No. 08/470,571 ("the '571 Application"). Additionally, at least 20 of the current Examples previously appeared in the 08/28/01 Office action in the '571 Application. Accordingly, applicants, in their 01/28/02 and 01/09/03 Responses filed in the '571 Application, have already fully responded on the record to all of the 30 Examples listed in the instant application.

In addition to the identical "Examples" being repeated from other recent Office actions, applicants note that many of the issues discussed in the 30 Examples have been raised by the Examiner before in slightly different forms in applicants' various copending applications. In addressing such issues, applicants have at all times strived to respond in a consistent manner in all of applicants' copending applications. Accordingly, applicants believe that the Examiner is mistaken in his assertion that applicants have "handled and addressed" the issues raised in the 30 Examples "inconsistently."

The 30 Examples are not relevant to the instant application, and applicants respectfully request that the Examples be withdrawn and that the Examiner acknowledge the lack of relevance of the 30 Examples to the prosecution of the instant application. Notwithstanding applicants' position regarding the lack of relevance of the 30 Examples to the prosecution of the instant case, applicants provide the following responses[2] to the 30 Examples. Applicants reserve their right to further

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[2] More detailed responses to many of the Examples appear in, among other places, applicants' 01/28/02 Response, 05/06/02 Response to Interview Summary, and 01/09/03 Response filed in the

address any of the 30 Examples if, for example, they are ever raised in the context of an actual rejection or objection.

Examples 1-3

Examples 1-3 address various issues concerning applicants' ability to claim priority to their 1981 application and the proper test for demonstrating priority under 35 U.S.C. § 120. Because applicants have not asserted priority to their 1981 application for any of the pending claims in the instant application, Examples 1-3 are wholly irrelevant to the instant application.

In Example 1, the Examiner discusses prosecution of applicants' copending application Ser. No. 08/470,571. More specifically, the Examiner focuses on the need to first demonstrate written description support in applicants' 1987 specification when claiming priority under § 120. Applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application, and applicants have identified detailed written description support in their 1987 specification for each and every pending claim in the instant application in Appendix B. Further, applicants respectfully disagree with the Examiner's characterization of their position regarding priority in their copending applications. Finally, in addition to being totally irrelevant to the instant application, applicants submit that the assertions made by the Examiner in Example 1 are improper in the absence of any priority claim made by applicants under 35 U.S.C. § 120 to their 1981 application for any claim in the instant application.

In Example 2, the Examiner takes issue with applicants' discussion and position regarding the proper test for demonstrating priority under § 120. Again, the Examiner refers to applicants' responses filed in the '571 Application. Although applicants continue to disagree with the

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'571 Application.

Examiner's description and application of the legal test for demonstrating priority under § 120 (for the detailed reasons set forth by applicants, e.g., in their 01/09/03 Response in the '571 Application), the issue of priority under § 120 is simply not an issue in the instant application.

In Example 3, the Examiner further discusses applicants' ability to demonstrate priority under § 120 and their ability to support claims pending in the '571 Application using applicants' 1987 specification. Applicants believe that the issues raised in Example 3 are irrelevant to the instant application and submit that the Examiner has mischaracterized applicants' position regarding their ability to demonstrate written description support in both the 1987 and 1981 specifications for the claims pending in the '571 Application and other applications in which applicants are asserting priority under § 120.

Applicants' positions with respect to the various issues related to applicants' ability to claim priority to the date of their 1981 specification and the proper legal test for demonstrating priority under § 120 has been discussed in detail in applicants' submissions in the '571 Application. Applicants will continue to provide the factual and legal bases that justify their claim of priority to their 1981 application in those copending applications where such claim is appropriate and necessary (i.e., if intervening art is applied and applicants elect to invoke § 120 to overcome such intervening art).

Example 4

In Example 4, the Examiner discusses a claim limitation (i.e., "locally generating" images) relevant to certain claims pending in applicants' '571 Application. Applicants respectfully disagree with the Examiner's assertion in Example 4 that Teletext decoders locally generate images for output or display in the same manner that is being claimed in certain ones of applicants' copending applications, and applicants have already addressed the issue of whether the prior art applied by the

Examiner teaches local generation of images in the '571 Application. If the Examiner bases a rejection of or objection to any claim pending in the instant application on the issues found in Example 4, or asserts that the issues found in Example 4 are in any way relevant to the instant application, applicants will address any such assertions at the appropriate time.

Examples 5 and 27

In Examples 5 and 27, the Examiner discusses the "Teletext prior art" and the inventions disclosed in applicants' 1987 specification in the context of an Office action and a Response filed in the '571 Application. The Examiner asserts in Examples 5 and 27 that applicants' 1987 "packetized SPAM" structure represents little more than applicants' own version of a "conventional extended Teletext system." In Example 27, the Examiner further asserts that certain structures recited in some of applicants' claims pending in the '571 Application (namely, a receiver, a signal detector, a processor, and an output device) are also "found within a conventional CPU/MP/computer implemented Teletext" receiver. These examples are not discussed or applied in the context of any of the claims pending in the instant application and the Examiner does not reject any of the pending claims based on the arguments made in Examples 5 and 27. If and when the Examiner makes rejections of specific pending claims on the basis of issues raised in Examples 5 and 27, applicants will further respond to such a rejection. Notwithstanding the lack of relevance of Examples 5 and 27 to this application, applicants strenuously disagree with the Examiner's disparaging assertions and characterization of the subject matter disclosed in applicants' 1987 specification. Finally, applicants note that they have previously addressed how applicants' claims differ from many "Teletext" prior art references in prior responses filed in copending applications.

Example 6

In Example 6, the Examiner discusses applicants' ability to obtain priority to their 1981 filing date for claiming "computer software." The Examiner discusses this issue with respect to arguments advanced in applicants' '571 Application related to applicants' prior use of the term "programming" in claims pending in the '571 Application. Applicants have fully addressed the issues raised in Example 6 in the '571 Application. The issues raised in Example 6, however, are not relevant to the instant application because applicants have not asserted priority under § 120 to the date of their 1981 application for any of the pending claims in the instant application. In fact, in Example 6, the Examiner acknowledges that applicants' 1987 specification does disclose the downloading of computer software. Notwithstanding the lack of relevance of Example 6 to this application, applicants disagree with the Examiner's position regarding applicants' ability to obtain priority to their 1981 filing date for claims that include the term "programming."

Example 7

In Example 7, the Examiner alleges that Teletext decoders found in the prior art are "signal processors" as the term "signal processor" is used within the context of applicants' claims pending in the '571 Application. Again, the issues raised in Example 7 are not discussed in the context of any claim currently pending in the instant application. Applicants do not understand the relevance of Example 7 to any of the claims currently pending in the instant application and no attempt is made to apply the discussion in Example 7 to the instant claims. Notwithstanding the lack of relevance of Example 7 to this application, applicants respectfully disagree with the Examiner's assertions and characterization of Teletext decoders found in the prior art and the signal processor disclosed by applicants. Applicants submit that the signal processors disclosed in applicants' specifications perform functions that are not disclosed in the cited Teletext prior art references. Finally, applicants

will address these issues if and when an actual rejection is made by the Examiner based on the issues raised in Example 7.

Example 8

In Example 8, the Examiner asserts that it is applicants' position that applicants' claimed/disclosed technology is not "correlated/analogous" to Teletext technology. The Examiner, however, fails to provide any details regarding his position that "conventional Teletext systems" generally are correlated or similar to applicants' claimed technology. Indeed, such generalized "correlations" or "analogies" are wholly irrelevant to the issue of whether or not applicants' claims are patentable. Applicants' position is that none of the specific references, related to Teletext or otherwise, alone or in combination, teach the methods and apparatus claimed by applicants. The Examiner further argues that applicants have previously indicated it is their belief that the scope of many of their pending claims encompasses the "Weather Star" system/receiver technology. First, the question of whether or not a particular system would be covered by a pending claim is wholly irrelevant to the examination of the instant claims, unless such system is prior art. The Examiner has not established that the Weather Star system is prior art. Second, although the Examiner vaguely refers to applicants' "pending amended claims," he makes no reference to a specific application *or a specific claim.* Due to the Examiner's broad treatment of these issues, applicants cannot respond in any meaningful manner to the issues raised in Example 8.

Example 9

In Example 9, the Examiner discusses an issue that arose in the prosecution of the '571 Application regarding whether "digital television signals/programming" was well known in the relevant art at the time that applicants filed their specifications. In their 1/28/02 Response filed in the '571

Application, applicants fully addressed the Examiner's rejections under § 112, second paragraph, of claims with limitations of "digital television." Further, applicants maintain their position stated in the '571 Application regarding the Schwartz et al. reference. Applicants note that there are no rejections of or objections to any of applicants' pending claims in the instant application based on the issues raised in Example 9, and applicants reserve the right to further respond to the issues raised in Example 9 if any of these assertions are relied on to object to or reject any claim in the future.

Example 10

In Example 10, the Examiner discusses two references of Zaboklicki: DE 2,914,981 and GB#2,016,874. Despite the Examiner's characterization of applicants' arguments regarding these references, applicants maintain that neither Zaboklicki reference anticipates or renders obvious any of applicants' pending claims in the instant application. Applicants have previously addressed issues raised in Example 10 in the '571 Application, and applicants will continue to address in detail any rejection under § 102 or § 103 in which a Zaboklicki reference is applied.

Examples 11, 12, 15 and 16

In Examples 11, 12, 15 and 16, the Examiner discusses applicants' use of the term "programming" in the 1981 and 1987 specifications. More specifically, Examples 11, 12, 15 and 16 assert that applicants cannot claim a 1981 priority date for claims including the term "computer programming," because of an allegedly narrow definition of that term in the 1981 specification. The issues raised in Examples 11, 12, 15 and 16 are only relevant if applicants rely on § 120 to obtain the benefit of their 1981 filing date. As applicants have not claimed priority to their 1981 application for any claims currently pending in this application, the issue is not relevant to the instant application. If and when the Examiner asserts that the issues found in Examples 11, 12, 15 and 16 are relevant to the claims

pending in the instant application, applicants will respond at the appropriate time. Finally, applicants have fully addressed the "programming" issues raised in these examples in several prior responses filed in the '571 Application.

Example 13

In Example 13, the Examiner discusses whether or not radio and television arts represent non-analogous arts. The Examiner states that applicants have previously asserted that the radio and television arts are non-analogous arts. The Examiner's assertions in Example 13 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 13 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim based on specific applied references in the identified arts.

Example 14

In Example 14, the Examiner discusses issues related to a claim recitation (simultaneous and sequential) in the context of two of applicants' copending applications (i.e., the '571 Application and Application Ser. No. 08/469,078. The Examiner's assertions in Example 14 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 14 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Additionally, applicants note that they have fully addressed issues related to the Examiner's concerns regarding "simultaneous and sequential" in their January 28, 2002 Response filed in the '571 Application.

Examples 17-20 and 23-26

Examples 17-20 and 23-26 discuss various issues related to applicants' ability to obtain a priority date based on their 1981 application and the proper legal test to be applied when analyzing an applicants' ability to obtain a priority date under § 120. None of the issues discussed in Examples 17-20 and 23-26 is relevant to the instant application because applicants have not asserted a 1981 priority date for the claims pending in the instant application. Further, applicants have addressed the issues related to priority in detail in their responses filed in the '571 Application and Application Ser. No. 08/487,526.

Example 21

In Example 21, the Examiner describes and compares the technology disclosed by applicants in their 1981 and 1987 specifications and asserts that the technology disclosed in applicants' two specifications is "vastly different." While it is true that the 1987 application includes many enhancements and improvements, applicants maintain that the subject matter disclosed in their 1981 application is also disclosed in the 1987 application. Second, because applicants have not asserted a 1981 priority date for the claims pending in the instant application, applicants' 1981 specification and any comparison between applicants' 1981 and 1987 specifications are not relevant to the instant application. Finally, the issues raised in Example 21 have previously been addressed in the '571 Application. Applicants will continue to provide appropriate factual and legal arguments as to why they are entitled to a 1981 priority date in all cases where it is relevant.

Example 22

In Example 22, the Examiner discusses a perceived difficulty in interpreting terminology in applicants' claims in light of the 1981 and 1987 specifications. More specifically, the Examiner

asserts that certain terminology in applicants' claims takes on different interpretations when such terminology is read on different teachings from applicants' 1981 and 1987 disclosures. The alleged "problem" described in Example 22 is simply not applicable to the instant application because applicants have not asserted a priority date based on their 1981 application for any claim pending in the instant application. In the instant application, only the 1987 specification is used to support the pending claims. Accordingly, the issues raised by the Examiner in Example 22 are not relevant to the instant application. Further, applicants have fully addressed Example 22 in the '571 Application.

Example 28

In Example 28, the Examiner discusses a specific claim pending in the '571 Application (claim 56). Specifically, the Examiner questions applicants' written description support for the recitation "interactive ultimate receiver station" previously appearing in claim 56 of the '571 Application. Applicants maintain that both the 1981 and 1987 specifications unquestionably disclose "interactive receiver stations." *See, e.g.,* 1981 Specification col. 20, ll. 23-27, and "Local Input" in Figure 6D; 1987 Specification, p. 288, ll. 1-20. The Examiner's assertions in Example 28 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 28 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Finally, applicants note that they have already fully addressed Example 28 in the '571 Application.

Example 29

Example 29 discusses limitations directed to combining images (e.g., where a "portion" of an image is "replaced" by a portion of another image) which are allegedly present in claims in applicants' '571

Application. Applicants maintain that applicants' specifications broadly teach the combining of images. The Examiner's assertions in Example 29 do not form the basis for any rejection of or objection to any specific claim pending in the instant application. To the extent necessary, applicants will further address the issues raised by the Examiner in Example 29 if and when such issues are ever raised in the context of a rejection of or objection to a specific pending claim. Further, applicants have already fully addressed the issues raised in Example 29 in the '571 Application.

Example 30

In Example 30, the Examiner discusses the publication date of article/reference by Gunn et al. Applicants acknowledge that the Gunn reference is a transcript from a conference in London that took place from March 26-28, 1980. But this information alone does not qualify the reference as prior art (i.e., it was unclear when the paper was published). However, since the mailing of the 7/17/02 Office action in the '571 Application, applicants received a copy of the Gunn reference that bears a Massachusetts Institute of Technology Library received stamp dated December 4, 1980. The Examiner also alleges in Example 30 that applicants have previously neglected to provide the Office with information regarding the publication dates of many references. Applicants have diligently supplied the Office with references as they have become known to applicants. In some instances, applicants were not provided with dates of certain references, so applicants were not able to provide the Office with dates for each and every reference identified on some of applicants' Information Disclosure Statements. Additionally, applicants submit that the discussion in Example 30 is not relevant to the instant application because the Gunn reference is not applied against any claim pending in the instant application.

B. Response To Rejections Under Section 112, Second Paragraph.

Section II of the Office action rejects claims 6, 7, 25, 79, 125, 129, and 139 under 35 U.S.C. § 112, second paragraph, allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants address each ground of rejection under the second paragraph of Section 112 as follows.

The Office action alleges that claims 6, 7, 25, 125, and 139 and because they are loaded with functional language. However, there is nothing inherently wrong with defining some part of an invention in functional terms. M.P.E.P. § 2173.05(g). "A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. *Id.* The pending claims as amended are clear for the reasons set forth in Section 2173.05(g) of the M.P.E.P. In claim 6, the step of transmitting a first control signal is set forth. The first control signal is properly and clearly set forth using functional limitations to define the effect of the control signal at a receiver station. Claims 7, 25, 139 also each set forth step of manipulating a control signal where the control signal is defined using functional limitations. Claim 125 sets forth an apparatus. As noted above, functional limitations may properly be to define a capability of a recited element. Accordingly, applicants respectfully assert that the use of the functional limitations found in claims 6, 7, 25, 125, and 139 are entirely proper and do not render these claims confusing as asserted in the Office action. Applicants therefore respectfully request the withdrawal of this rejection under the second paragraph of 35 U.S.C. § 112.

The Office action asserts that references to the control signal in claim 7 are confusing because it is not clear if they refer back to the control signal as received or stored. The initial step of

claim 7 is amended to set forth storing a control signal. The following recitations of the control signal clearly refer to this control signal introduced in the initial step.

It is further asserted in the Office action, that "said processor code" recited in the last line of claim 129 has multiple antecedent bases. Claim 129 is amended to delete reference to processor code.

C. Response To Rejection Under Section 112, First Paragraph.

The Examiner prefaces his rejections under § 112, first paragraph, by listing a series of quotations from a decision issued in prior litigation pending before the International Trade Commission (ITC) involving one of applicants' issued patents. In Section III, the Examiner simply lists several quotations and the states that the Examiner "continues to adopt these same positions in regard to the pending amended claims currently at issue." Apparently, the Examiner includes these quotations to support his rejections under § 112, first paragraph. The Examiner, however, fails to provide any discussion or explanation regarding the proper procedural and factual context of these quotes. Placed in an accurate and proper context, the record from the ITC litigation actually supports applicants' position that the pending claims are justified by the instant specification.

Before addressing the specific passages quoted in the Office action, applicants must first provide a procedural overview of the ITC litigation. In the litigation before the ITC, the owner of applicants' issued patents and the assignee of the instant application, Personalized Media Communications L.L.C. (PMC), alleged that certain products imported into the United States infringed several claims of U.S. Patent No. 5,225,277. Following an evidentiary hearing, the ITC administrative law judge, Judge Luckern, issued a decision entitled "Initial and Recommended Determinations" (Initial Determinations) on October 20, 1997. *See In re Certain Digital Satellite*

Sys. (DSS) Receivers & Components Thereof, No. 337-TA-392, 1997 WL 696255 (Int'l Trade Comm'n Oct. 20, 1997). In connection with the evidentiary hearing, three separate groups submitted briefs and arguments to Judge Luckern: 1) PMC; 2) the accused infringers (Respondents); and 3) the ITC Staff. Judge Luckern's Initial Determinations made various findings and concluded that: 1) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as indefinite; 2) claims 3, 6, 7, 12, 15, 35, and 44 were invalid as not enabled; 3) claim 7 was invalid as anticipated; and 4) no asserted claim was infringed. Significantly, the Respondents challenged only one claim, claim 44, for lack of written description support. Judge Luckern found that claim 44 was *not invalid* under § 112, first paragraph, for a failure to provide proper written description support. *Thus, no claim asserted in the ITC litigation was held invalid by Judge Luckern under 35 U.S.C. § 112, first paragraph, for failure to provide adequate written description support.*

On December 4, 1997, the ITC issued its Final Determination, which adopted some, but not all, of Judge Luckern's Initial Determinations. Specifically, the ITC's Final Determination adopted Judge Luckern's claim constructions and findings that the asserted claims were indefinite and not infringed. On the other hand, the ITC did not adopt Judge Luckern's other findings concerning, for example, whether the claims were enabled or whether claim 7 was anticipated. On appeal before the Federal Circuit were only those findings by Judge Luckern that the ITC expressly adopted in its Final Determination. The Federal Circuit's opinion: 1) reversed Judge Luckern's and the ITC's determination that the asserted patents claims were invalid for indefiniteness; 2) vacated Judge Luckern's and the ITC's determination that asserted claim 7 was not infringed; and 3) affirmed Judge Luckern's and the ITC's determination that claims 6 and 44 were not infringed. *See Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 48 USPQ2d 1880 (Fed. Cir. 1998). As a result of the Federal Circuit opinion, the case was remanded to the ITC. After

the case was remanded to the ITC, PMC withdrew its complaint and the ITC vacated Judge Luckern's Initial Determination with respect to the findings of invalidity for anticipation and lack of enablement. *See In re Certain Digital Satellite Sys. (DSS) Receivers & Components Thereof*, No. 337-TA-392, 2001 WL 535427 (Int'l Trade Comm'n May 13, 1999). Accordingly, the quotes relied upon by the Examiner in the Office action, all of which are from Judge Luckern's discussion of invalidity for lack of enablement, were vacated by the ITC.

As applicants have already noted, with respect to the only claim even challenged under the written description requirement of § 112, Judge Luckern concluded that the claim was *not invalid* on that basis.[3] Regarding the first quote, Judge Luckern's belief that the 1987 specification is "difficult to understand as it is dealing with many possible systems," even if true, is not a proper reason for the Examiner to conclude that none of applicants' claims are supported under § 112. Regarding the second quote, in which Judge Luckern discusses the complainant's identification of written description support for the asserted claims of U.S. Patent No. 5,225,277, what is important is that Judge Luckern did not find that any of the asserted claims were invalid for failure to satisfy the written description requirement of § 112. Finally, the last two quotes identified by the Examiner actually contain statements made by the ITC Staff in opening arguments. The comments advanced by the Staff in the ITC litigation describing "directions to a treasure map" and "ships passing in the night" are attorney arguments advanced during litigation, and such arguments are simply not indicative of applicants' actions before the PTO.

When the Examiner's citations to the ITC record are presented accurately and in their proper substantive and procedural context, the citations do not support the Examiner's position. Indeed, the

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[3] Additionally, in allowing the claims asserted in the ITC to issue, the PTO understood that those claims were adequately supported under § 112.

ITC record is consistent with applicants' position on the written description issue. The statements relied upon by the Examiner are nothing more than dicta concerning a finding by Judge Luckern that was later vacated. Further, even if these findings had not been vacated, the observations by Judge Luckern do not contradict applicants' position that the pending claims are properly supported under § 112, first paragraph.

In Section III, the Examiner rejects all claims under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not sufficiently described in the specification. In making these rejections, however, the Examiner does nothing more than identify specific limitations pending in a given claim and state "it is not clear where the disclosure as originally filed described the recited step/process . . . " There is absolutely no analysis of, reference to, or discussion of any of the teachings found in applicants' specification which relate to the claimed subject matter. Because the Examiner has failed to provide any reason or analysis as to *why* applicants' claims are not sufficiently supported under 35 U.S.C. § 112, first paragraph, the Examiner has failed to meet his burden to sustain such a rejection.

An Examiner has the initial burden of presenting a prima facie case of unpatentability by:

> "[P]resenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." . . . [T]he burden placed on the examiner varies, depending on what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. If, on the other hand, the specification contains a description of the claimed invention, albeit not *in ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. Once the examiner or Board carries the burden of making out a prima facie case of unpatentability, "the burden of coming forward with evidence shifts to the applicant." . . . [to] show that the invention is adequately described to one skilled in the art.

In re Alton, 76 F.3d 1168, 1175 (Fed. Cir. 1996) (citations omitted).

As the Alton case makes clear the Examiner's burden varies in making a valid rejection under § 112, first paragraph. In the Office action, the Examiner has not even met the most lenient burden described in Alton. The Examiner does not assert that applicants' claims or specific limitations in applicants' claims are completely outside the scope of the specification; the Examiner simply identifies specific claim limitations and requests "clarification." Accordingly, under the standard set forth in *Alton*, the Examiner has not met his burden to "provide reasons why one of ordinary skill in the art would not consider the description sufficient." *Alton*, 76 F.3d at 1175.

Notwithstanding the Examiner's failure to meet his burden for making a proper rejection of applicants' pending claims under § 112, first paragraph, applicants have provided a chart (attached as Appendix B) that identifies detailed written description support for each and every limitation of the pending claims. Applicants respectfully submit that the illustrative support identified in Appendix B, together with applicants' narrative discussion below, demonstrates that the claimed subject matter is described in the specification in such a way as to reasonably convey to one skilled in the art that applicants had possession of the claimed inventions at the time the 1987 application was filed. Applicants wish to note that the support provided below and in Appendix B is illustrative and the claims may be supportable by other/additional teachings of the 1987 specification. Applicants also wish to note that the claims of the instant application should not be construed to be limited based on the support provided.

1) Claim 6 And Claims Depending Therefrom

Claim 6 sets forth a method of delivering a receiver specific program at a receiver station. The specification includes a detailed description of many inventive features in the context of

providing a commercial including various receiver specific content in among other places Example #10. A description of network control of generation and embedding of signals at a transmitter station is provided from pages 374 through 390. A description of the resulting coordination of programming at receiver stations is provided from pages 469 through 516. The specific limitations of claim 6 are found in the specification as set forth below.

In claim 6, a first control signal is transmitted to a receiver station. The first control signal is generated at the transmitter station. The first control signal is effective at a computer at the receiver station to control a receiver specific value by processing information stored at the computer, generate a receiver signal based on the receiver specific value, and output programming based on the receiver specific signal. A second control is received at the transmitter station in response to which the first control signal is transmitted.

The specification discloses transmitting a particular program-instruction-set SPAM message to receiver stations. Spec. p. 386, ll. 7-14, p. 484, ll. 7-9. The program-instruction-set message is generated at the transmitter station of Fig. 6. Spec. p. 385, ll. 9-17. An effect of the program-instruction-set message is the loading and execution of a program instruction set at microcomputer, 205, of the receiver station of Figs. 7 and 7F. Spec. p. 484, ll. 7-18. Under control of the program instruction set microcomputer, 205, generates specific information of a series of outputs. Spec. p. 485, ll. 10-13. An example of one of the receiver specific outputs in the display of "$1,071.32" which is the price to have all the pork needed to entertain 500 people delivered to the address of the receiver station. Spec. p. 490, ll. 4 - p. 491, l. 16. Under control of the program instruction set microcomputer, 205, calculates the value 1,071.32 based on data stored in DATA_OF.URS and DATA_OF.ITS files. Spec. p. 485, l. 14 - p. 486, l. 18. A video signal of "$1,071.32" is generated based on the calculation. Spec. p. 486, ll. 20 - 27. Programming of the conventional video

information and the video information of "$1,071.32" is output based on the video signal. Spec. p. 491, ll. 10-16. A transmit-and-execute-program-instruction-set message is received at the transmitter station in response to which the program-instruction-set message is transmitted. Spec. p. 385, ll. 3-8, p. 385, l. 35 - p. 386, l. 6.

Further support for claim 6 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 6 is clearly supported by the above description in combination with Appendix B. Claims 21, 22, and 33 depend from claim 6. The support for these claims is thus based on the support discussed above with respect to claim 6. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

2) Claim 7 And Claim Depending Therefrom

Claim 7 sets forth a method of delivering a receiver specific program at a receiver station. In claim 7, a control signal and selected data are stored at a transmitter station. An information transmission is transmitted that includes the control signal and the selected data. The control signal is effective at the receiver station to control a computer to compute a receiver specific value by processing data stored in the computer including the selected data, generated a receiver specific signal based on the receiver specific value and output programming based on the receiver specific signal.

The specification discloses storing PROGRAM.EXE and DATA_OF.ITS files at the memories of computer, 73, at the transmitter station of Fig. 6. Spec. p. 382, ll. 2-4. The transmission of programming of the commercial (unit Q) includes the data-module-set message

including DATA_OF.ITS (Spec. p. 383, 26-34, p. 385, ll. 1-2.) and the program-instruction-set message including PROGRAM.EXE (Spec. p. 379, ll. 21-24, p. 385, l. 35 - p. 386, l. 3).

Further support for claim 7 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 7 is clearly supported by the above description in combination with Appendix B. Claim 34 depends from claim 7. The support for claim 34 is thus based on the support discussed above with respect to claim 7. The specific support for the elements set forth in claim 34 is fully demonstrated in the charts contained in Appendix B.

3) Claim 25 And Claims Depending Therefrom

In claim 25, a control signal is transmitted to a receiver station. Information is received regarding the first control signal. A second control signal is also received that causes a computer at the transmitter station to select data and communicate the first control signal to memory of the computer based on the data. The first control signal is operative at the receiver station to control a computer to generate a receiver specific value by processing information stored in the computer, generate a receiver specific signal based on the receiver specific value, and communicate programming to an output device based on the receiver specific signal.

The specification discloses transmitting a program instruction set that is stored in a file named PROGRAM.EXE to a receiver station. Spec. p. 379, ll. 21-24, p. 385, l. 35 - p. 386, l. 3. Information of the intermediate generation set in received and is used to generate the program instruction set. Spec. p. 378, ll. 7-28. The load-set-information message is received and causes computer, 73, at the transmitter station of Fig. 6 to select the file PROGRAM.EXE which includes selected local-formula-and-item information and communicate it to RAM memory of the computer.

Spec. p. 381, l. 23 - p. 382, l. 6. Under control of the program instruction set, which is in the file PROGRAM.EXE, microcomputer, 205, calculates the value 1,071.32 based on data stored in DATA_OF.URS and DATA_OF.ITS files. Spec. p. 485, l. 14 - p. 486, l. 18. A video signal of "$1,071.32" is generated based on the calculation. Spec. p. 486, ll. 20 - 27. Programming of the conventional video information and the video information of "$1,071.32" is output based on the video signal. Spec. p. 491, ll. 10-16.

Further support for claim 25 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 25 is clearly supported by the above description in combination with Appendix B. Claims 26-29 depend from claim 25. The support for these claims is thus based on the support discussed with respect to claim 25. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

4) Claims 35 And Claims Depending Therefrom

Claim 35 sets forth as method of delivering a receiver specific program at a receiver station. In claim 35, an information transmission comprising units of programming and a control signal is received. The units of programming are communicated to a computer or output device. The control signal is detected and passed to a computer. The computer is controlled based on the control signal. Under this control the computer generates a receiver specific value by processing information that is stored in the computer. One of the units of programming is selected. The selected unit of programming is output under control of the computer. A presentation of the selected unit of programming and another unit of programming is thus delivered.

The specification discloses an transmission of the commercial including conventional television video and audio and information of DATA_OF.ITS and also the program instruction set. Spec. p. 478, ll. 25-26, p. 482, ll. 32-35, p. 484, ll. 1-6. The television information and embedded signals, which include the data-module-set message with the DATA_OF.ITS file, are communicated to microcomputer 205. Spec. p. 479, ll. 25-32. The television information and certain program units selected from the DATA_OF.ITS file are communicated to monitor, 202M. Spec. p. 480, ll. 10-17. The program instruction set is detected and passed to microcomputer, 205. Spec. p. 484, ll. 7-18. Microcomputer, 205, is controlled based on the program instruction set. Spec. p. 485, ll. 14-18. Under the control of the program instruction, microcomputer generates the percentage value of savings of the commercial offer. Spec. p. 488, ll. 14-22. The audio information of the announcer's voice saying the generated percentage savings is selected. Spec. p. 488, ll. 24-27. This audio information is output. Spec. 492, ll. 23-30. A presentation of the selected audio of the announcer's voice and the conventional audio and video of the announcer are delivered. Spec. p. 491, l. 30 - p. 492 l. 30.

Further support for claim 35 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 35 is clearly supported by the above description in combination with Appendix B. Claims 36-38 depend from claim 35. The support for these claims is thus based on the support discussed with respect to claim 35. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

5) Claim 55 And Claims Depending Therefrom

Claim 55 sets forth a method of signal processing at a receiver station. In claim 55, an information transmission is received including a program and a control signal. The program is selected and transferred to an output device. The control signal is detected and passed to a computer. The computer is controlled to generate a receiver specific datum by processing information that is stored in the computer. The receiver specific datum is placed at a specific memory location of the computer. The receiver specific datum is communicated from the specific memory location to the output device. The specific memory location is then cleared of the receiver specific datum. The program thus includes combined medium programming including the receiver specific datum that is delivered in the time period between placing the receiver specific datum in memory and clearing the receiver datum from memory.

The specification discloses receiving television information including a control signal. For example, the television information of the commercial discussed in Example 10 is includes control signals such as the program instruction set. Spec. p. 484, ll. 12-17. The program is selected by tuner, 215, and transferred to monitor, 202M. Spec. p. 479, ll. 21-25. The program instruction set is detected and passed to microcomputer, 205. Spec. p. 484, ll. 12-17. Microcomputer, 205, is controlled to generate a datum of the percentage saving of the offer in the commercial by processing the full cost information stored in DATA_OF.ITS. Spec. p. 485, ll. 14-18, p. 488, ll. 5-23. The percentage savings datum is placed in audio RAM of the computer, 73. Spec. p. 488, ll. 21-27. The percentage savings datum is communicated from the audio RAM to the monitor, 202M. Spec. p. 492, ll. 23-26. The audio RAM is then cleared of the percentage savings datum. Spec. p. 493, ll. 33-34. The commercial thus includes combined medium programming including the percentage savings

datum delivered in the time period between placing the percentage savings datum in audio RAM and clearing the percentage savings datum from the audio RAM.

Further support for claim 55 is provided in Appendix B. Claims 56 and 60 depend from claim 45. The support for these claims is thus based on the support discussed with respect to claim 43. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

6) Claim 78

Claim 78 sets forth an apparatus for signal processing to deliver combined medium programming including a receiver specific datum within a program. The apparatus includes an output device for delivering the program. A decoder detects control signals in an information transmission. A computer is connected to the output device and the decoder. The computer performs steps generating a datum, placing the datum in memory, communicating the datum, and clearing the memory in a manner similar to the method discussed above with respect to claim 55.

The specification discloses monitor 202M for delivering a program including the commercial discussed above with respect to claim 55. Spec. p. 480, ll. 14-17. Decoder, 203, detects the program instruction set. Spec. p. 484, ll. 12-15. Microcomputer, 205, is connected to monitor 202M and decoder 203. Spec. p. 480, ll. 11-14, p. 484, ll. 15-16. Microcomputer, 205, includes video and audio RAM in which is stored receiver specific data. Spec. p. 486, ll. 20-27, p. 488, ll. 24-27. The computer performs the steps set forth with audio information in the manner described above with respect to claim 55 and with video as shown in Appendix B.

7) Claim 79 And Claims Depending Therefrom

Claim 79 sets forth a method of communicating program material. In claim 79, a program to be transmitted is received. A control signal is stored at a transmitter station. The control signal operates at a receiver station to generate a receiver specific value and to select audio for output based on the receiver specific value. An information transmission including the program and the control signal is transmitted at a specific time.

The specification discloses receiving a commercial designated as unit Q. Spec. p. 478, ll. 23-26, p. 343, ll. 26-32. The program instruction set in the file named PROGRAM.EXE is stored at the transmitter station of Fig. 6. Spec. p. 365, ll.7-21. The program instruction set operates at a the receiver station of Fig. 7 to generate the value of the savings of the commercial offer. Spec. p. 488, ll. 16-24. Audio information for output to monitor 202M is selected based on the savings value. Spec. p. 488, ll. 24-27. A transmission including the conventional audio and video of the commercial and the program-instruction-set message is transmitted at the time specified by the transmit-and-execute-program-instruction-set message. Spec. p. 367, ll. 8-9, p. 371, ll. 4-12, p. 372, ll 4-6.

Further support for claim 79 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 79 is clearly supported by the above description in combination with Appendix B. Claims 89 and 103-111 depend from claim 79. The support for these claims is thus based on the support discussed with respect to claim 79. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

8) Claim 125

Claim 125 sets forth an apparatus for processing a signal and communicating program materials to present at receiver stations. The apparatus includes a transmitter for communication an information transmission to receiver stations. A program input receiver in connected to the transmitter for communicating a program to the transmitter. A memory or recorder is connected to the transmitter for storing and communicating a control signal. The control signal operates to generate a receiver specific datum at a receiver station. An input device is connected to the memory or recorder to communicate the control signal at a specific time. The program and control signal act at the receiver station as discussed above with respect to claim 79.

The specification discloses intermediate transmitter stations for transmitting programming. Spec. p. 324, ll. 11-21. The intermediate transmitter station receives programming for retransmission. Spec. p. 375, ll. 4-6. A memory is included in computer 73. Spec. p. 382, ll. 3-5. The computer 73 records information. Spec. p. 378, ll. 11-23. The program instruction set is stored at computer 73 and its memory. Spec. p. 379, ll. 21-28. The program instruction set operates to generates a receiver specific price at the receiver station. Spec. p. 486, ll. 20-24. The intermediate transmission station decodes messages that are input to computer 73. Spec. p. 377, ll. 19-25. The program instruction set is communicated at specific time based on input from the transmit-and-execute-program-instruction-set message. Spec. p. 385, ll. 3-30. The operation of the control signal is discussed above with respect to claim 79.

Further support for claim 125 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 125 is clearly supported by the above description in combination with Appendix B.

9) Claim 127 And Claims Depending Therefrom

Claim 127 sets forth a method of transmitting program material to receiver stations. In claim 127, a program to be transmitted is received at a transmitter station. Data related to the program is generated. A first control signal is generated at the transmitter station using the generated data, which at the receiver station operates to generate a receiver specific datum. A second control signal is received. The program or first control signal is transmitted in response to the second control signal.

The specification discloses receiving a commercial designated as unit Q. Spec. p. 342, ll. 26-31. Data included in the program instruction set of Q is computed. Spec. p. 379, ll. 5 -26. A program-instruction-set message is generated at the transmitter station of Fig. 6 using the data. Spec. p 385, ll. 9-13. The program-instruction-set message operates to generate receiver specific overlays at the receiver stations. Spec. p. 485, ll. 14-18. A cuing message is received. Spec. p. 367, ll. 2-7. The program and program instruction set is transmitted in response to the cuing message. Spec. p. 367, ll. 8-9, p. 372, ll. 2-6.

Further support for claim 127 is provided in Appendix B. Applicants respectfully assert that each limitation specifically called out in the Office action and remaining in amended claim 127 is clearly supported by the above description in combination with Appendix B. Claim 129 depends from claim 127. The support for these claims is thus based on the support discussed with respect to claim 127. The specific support for the elements set forth in these claims is fully demonstrated in the charts contained in Appendix B.

D. Response To Prior Art Rejections

Section IV of the Office action rejects claims 6, 7, 25, 35, 55, 78, 79, 125, 129, and 139 under 35 U.S.C. § 103(a) as being unpatentable over "remote switching control system" as evidenced by British Patent Publication 959,274 (Germany) and U.S. Patent 4,847,698 (Freeman).

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j) (8th ed. 2001). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to support a § 103 rejection based on a combination of references, the Examiner must provide a sufficient motivation for making the relevant combinations. *See* M.P.E.P. §§ 2142 and 2143.01; *see also In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references."). It is well-settled that an Examiner can "satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some *objective teaching* in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (emphasis added); *see also In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir 2002) ("'deficiencies of the cited references cannot be remedied by the Board's general conclusions about

what is 'basic knowledge' or 'common sense'"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence [of a motivation to combine]'" and thus do not support rejections based on combining references. *In re Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Without objective evidence of a motivation to combine, the obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the requirement for such evidence is designed to combat, and without which the obvious rejection is insufficient as a matter of law. *Id.* at 999, 50 USPQ2d at 1617-18.

As set forth in greater detail below, the Examiner has failed to follow these requirements when making the § 103 rejection of the claims of the instant application. For this reason alone, the § 103 rejections should be withdrawn.

As initial matter, the claims are rejected over a concept of a remote switching control system as evidenced by Germany and Freeman. There is no showing that any system "evidenced" by Germany and Freeman is shown in the prior art that shows or suggests all the limitations of the rejected claims. It is simply not clear to what remote switching control system the Examiner refers in the Office action. Applicants respectfully assert that this rejection is improper to the extent that the remote switching control system referred to in the rejection is alleged to includes any features not expressly evidenced by the applied combination of references. Accordingly, applicants address this rejection as a rejection over Germany in view of Freeman.

There is no motivation found in the prior art to combine Germany with Freeman in the manner suggested in the Office action. At page 50 of the Office action it is stated:

> The system disclosed by Germany clearly transmitted conventional TV programming. Freeman exemplified a specific form of convention TV programming which was known to have been transmitted by conventional TV system. It would have been obvious for the network

TV programming that is transmitted by Germany to have been of the conventional form described in Freeman.

There is no support for this incorrect statement. As noted by the Examiner, Freeman is directed to a specific form of TV programming. The form is a television program in which two or more audio channels are synched to a common video channel. Freeman col. 2, ll. 48-50. Also, as noted by the Examiner, Germany clearly transmitted conventional TV programming. There is no teaching found in either Freeman or Germany that suggests the specialized programming of Freeman is compatible with the system set forth by Germany. To the contrary, the references teach away from this combination. The Germany system facilitates the insertion of local announcements, regional broadcasts, alternative advertisements and the like into primary programming. Germany p. 1, ll. 11-14. Freeman is directed to primary interactive programming in which audio messages are selected based on user selections. There is no suggestion to insert interactive programming of Freeman as local announcements or advertisements into programming in response to cue signals of Germany.

Furthermore, the combination of Germany with Freeman, even if improperly made, does not suggest the invention defined by the instant claims as amended. The claims are generally directed to generating receiver specific content. Neither Germany nor Freeman suggests generating receiver specific content. As noted by the Examiner, Germany is directed to conventional television. There is no receiver specific content suggested by Germany. Freeman merely provides for switching from one audio channel to another based on user input. There is no suggestion of creating receiver specific content, rather the multiple audio channel are transmitted with the video.

With respect to claim 6, the Examiner acknowledges that Germany fails to suggest a control signal that is effective to control a computer to compute a receiver specific value base on information stored therein, to generate and output a receiver specific signal based thereon. The Examiner asserts that Freeman suggests control signals that control the processing locally stored information in order

to generate a specific signal. Freeman suggests no such control signals, but rather teaches multiple audio channels. No control signal is transmitted with functions as set forth in claim 6. Furthermore, the Office action is silent regarding any teaching of a control signal that is operative to compute a receiver specific value as set forth by claim 6.

Claim 6 is further amended to set forth generating a first control signal at a transmitter station. Germany and Freeman fail to suggest generating a control signal at a transmitter station as set forth in claim 6 as amended.

Applicants respectfully request that the rejection of claim 6 under 35 U.S.C. § 103(a) be withdrawn for at least the above reasons.

Claims 7, 25, 35, 55, 78, 79, 125, 127, 129, and 139 stand rejected as being unpatentable over remote switching control system for the same reasons that were set forth for claim 6. The cancellation of claims 129 and 139 render this rejection moot with respect to these claims. There is no discussion of the particular limitations of these claims in the Office action. Accordingly, the Office action cannot establish a *prima facie* case of obviousness against these claims. However, as discussed above, each claim is related to generating receiver specific programming. The art relied upon includes no teaching regarding such generation as discussed above with respect to claim 6. Exemplary limitations from these claims not shown or suggested by the art relied upon are set forth below.

Claim 7 sets forth storing a control signal and selected data at a transmitter station. Claim 7 also sets forth a control signal that is effective to control a computer to compute a receiver specific value by processing information stored in the computer including the selected data, generate a receiver specific signal based on the receiver specific value, and output programming based on the

receiver specific signal. Germany and Freeman fail to suggest such as step of storing or such a control signal.

Claim 25 sets forth receiving information regarding a first control signal. Claim 25 also sets forth receiving a second control signal operative to cause a computer at the transmitter station to select the first control signal and communicated it to memory of the computer. Claim 25 also sets forth that the first control signal is operative to control a computer to compute a receiver specific value by processing information stored in the computer including the selected data, generate a receiver specific signal based on the receiver specific value, and output programming based on the receiver specific signal. Germany and Freeman fail to suggest such information, such a second control signal, and such a first control signal.

Claim 35 sets forth detecting a control signal in a broadcast or cablecast transmission. Claim 35 also sets forth controlling a computer based on the control signal to generate a receiver specific value, select a unit of programming based on the receiver specific value, and output the selected unit of programming. Germany and Freeman fail to suggest such a step of detecting and also fails to suggest such a step of controlling a computer.

Claim 55 sets forth detecting a control signal in an information transmission. Claim 55 also sets forth controlling a computer to generate a receiver specific datum, place the receiver specific datum at a specific memory location, communicate the receiver specific datum to an output device, and clear the specific memory location. Germany and Freeman fails to suggest such step of detecting and controlling a computer.

Claim 78 sets forth an apparatus including a computer for generating a receiver specific datum, placing the receiver specific datum at a specific memory location, communicating the

receiver specific datum to an output device, and clearing the specific memory location. Germany and Freeman fail to suggest such a computer.

Claim 79 sets forth storing at a transmitter station a control signal, which operates to generate a receiver specific value and to select audio for output based on the receiver specific value. Germany and Freeman fail to suggest such step of storing and such a control signal.

Claim 125 sets forth transmitter station apparatus including a memory or recorder for storing a control signal which at a receiver station operates to generate a receiver specific datum. Germany and Freeman fail to suggest such a memory or recorder and fail to suggest such a control signal.

Claim 127 sets forth generating data related to a program. Claim 127 also sets forth generating at a transmitter station a first control signal using the generated data which at the receiver station operates to generate a receiver specific datum. Germany and Freeman fail to suggest such generating steps.

Applicants therefore respectfully request the withdrawal of the rejections of claims 6, 7, 25, 35, 55, 78, 79, 125, and 127 as being unpatentable over remote switching control system for at least the above reasons.

E. Correspondence Address

Applicants note that the recent Office action was addressed to:

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To ensure that all communications are consistently and expeditiously received and in accordance with 37 C.F.R. § 1.33, applicants request that all correspondence be sent to the address associated with Customer Number 21967 presently corresponding to:

Hunton & Williams
Intellectual Property Department
1900 K Street, NW
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Washington, DC 20006-1109.

III. CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Reconsideration and allowance of the instant application are respectfully requested.

Respectfully submitted,

HUNTON & WILLIAMS

By: 
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Dated: March 5, 2003

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PTO/SB/44 (09-07)
Approved for use through 08/31/2013. OMB 0651-0033
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(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,840,976

APPLICATION NO.: 08/447,712

ISSUE DATE : October 19, 2010

INVENTOR(S) : John C. Harvey et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At claim 1, column 287, lines 5-6, insert --at-- so that lines 5-6 read, "1. A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using"
At claim 5, column 287, lines 46-47, insert --at-- so that lines 46-47 read, "5. A method of delivering a receiver specific program at at least one of a plurality of receiver stations, comprising using"
At claim 5, column 287, line 54, insert --to-- after "control a computer" and before "perform a step" so that the phrase reads, "control a computer to perform a step "
At claim 29, column 291, line 34, delete "at its output device"

MAILING ADDRESS OF SENDER (Please do not use customer number below):

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
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